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PATENT APPLICATION  
Docket: 6300.103

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: )  
McClane et al. )  
Serial No. 10/040,883 ) Art Unit  
Confirmation No. 8869 ) 3737  
Filed: January 7, 2002 )  
For: METHOD AND APPARATUS FOR RAMAN )  
IMAGING OF MACULAR PIGMENTS )  
Examiner: Baisakhi Roy )  
Customer No. 022913 )

## TERMINAL DISCLAIMER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Declarant, Rajiv Kulkarni, represents that he is the Senior Licensing Manager of The University of Utah Research Foundation, a non-profit corporation of the State of Utah, having a principal place of business at 615 Arapeen Drive, Suite 110, Salt Lake City, Utah 84108, and that he is authorized to make this Declaration and execute this Terminal Disclaimer on behalf of The University of Utah Research Foundation. Declarant further represents that The University of Utah Research Foundation is the assignee of the entire interest, as shown by the Assignment from The University of Utah recorded at reel 010063, frame 0765 (a copy of which is attached

hereto as Exhibit A) in the records of the U.S. Patent and Trademark Office, of the above-identified application. The University of Utah was the assignee of the entire interest, as shown by the Assignment from each of the inventors recorded at reel 010063, frame 0757 (a copy of which is attached hereto as Exhibit B) in the records of the U.S. Patent and Trademark Office, of the above-identified application.

Declarant hereby further certifies that the evidentiary documents at Exhibits A and B have been reviewed by him/her, and to the best of the Declarant's knowledge and belief, title is in the Assignee seeking to take action.

The Assignee hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of said U.S. Patent No. 6,205,364 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to said U.S. Patent No. 6,205,364, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

The Assignee does not disclaim any terminal part of any patent granted on the above-identified application that would extend beyond the term of said U.S. Patent No. 6,205,364 in the event that said U.S. Patent No. 6,205,364 later: (a) expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a); (b) has all claims cancelled by a reexamination certificate; or (c) is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Declarant further declares that all statements made herein of Declarant's own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application or any patent issuing thereon.

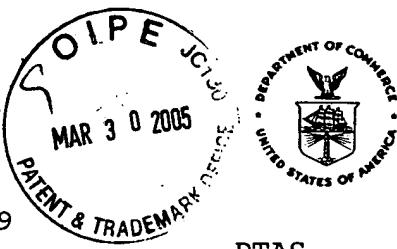
DATED this 21 day of March 2005.

THE UNIVERSITY OF UTAH  
RESEARCH FOUNDATION

By:

RK Kulkarni  
Name: RAJIV K. KULKARNI  
Title: SR. LICENSING MGR.

DFR0000007577V001



SEPTEMBER 01, 1999

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

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1000 EAGLE GATE TOWER  
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SALT LAKE CITY, UT 84111



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RECORDATION DATE: 06/18/1999

REEL/FRAME: 010063/0765  
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

UTAH, UNIVERSITY OF, THE

DOC DATE: 06/18/1999

ASSIGNEE:

UTAH, UNIVERSITY OF, RESEARCH  
FOUNDATION, THE  
615 ARAPEEN DRIVE, SUITE 110  
SALT LAKE CITY, UTAH 84108

SERIAL NUMBER: 09335932

FILING DATE: 06/18/1999  
ISSUE DATE:

TONYA LEE, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

FORM PTO-1595 (Modified)  
(Rev. 6-93)  
OMB No. 0651-0011 (exp. 4/94)  
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To the Honorable Commissioner of Patents  
1. Name of conveying party(ies):  
The University of Utah



Additional names(s) of conveying party(ies)  Yes  No

3. Nature of conveyance:

Assignment  Merger  
 Security Agreement  Change of Name  
 Other \_\_\_\_\_

Execution Date: June 18, 1999

4. Application number(s) or registration numbers(s):

If this document is being filed together with a new application, the execution date of the application is: 6/16/99 and 6/17/99

A. Patent Application No.(s)

B. Patent No.(s)

09/335932

Additional numbers attached?  Yes  No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Gregory M. Taylor

Internal Address: WORKMAN, NYDEGGER &amp; SEELEY

Street Address: 1000 Eagle Gate Tower

60 East South Temple

06/29/1999 TARTIS 00000008 09335932  
City: Salt Lake City State: UT ZIP: 841116. Total number of applications and patents involved: 

7. Total fee (37 CFR 3.41): ..... \$ 40.00

Enclosed - Any excess or insufficiency should be credited or debited to deposit account  
 Authorized to be charged to deposit account

8. Deposit account number:

23-3178

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Gregory M. Taylor

Name of Person Signing

Signature

Total number of pages including cover sheet, attachments, and document: 

6/18/99 Date

WHEN RECORDED, RETURN TO:

Workman, Nydegger & Seeley  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111

PATENT APPLICATION  
Docket No: 6300.99  
Express Mail Label No. EL243131406US

## A S S I G N M E N T

Whereas, The University of Utah, an institution of higher education of the State of Utah, having a place of business at 615 Arapeen Drive, Suite 110, Salt Lake City, UT 84108, is the owner of the entire right, title and interest in and to application for United States Letters Patent entitled **METHOD AND APPARATUS FOR NONINVASIVE MEASUREMENT OF CAROTENOIDS AND RELATED CHEMICAL SUBSTANCES IN BIOLOGICAL TISSUE**, Serial No. 09/335,932, filed June 18, 1999 in the names of Werner Gellermann, Robert W. McClane, Nikita B. Katz, and Paul S. Bernstein. (We hereby authorize the attorneys of Workman, Nydegger & Seeley to insert said serial number and filing date when known.)

Whereas, The University of Utah Research Foundation, a nonprofit corporation of the State of Utah, having a place of business at 615 Arapeen Drive, Suite 110, Salt Lake City, UT 84108, is desirous of acquiring the entire right, title and interest in and to the said invention within the United States of America and its territorial possessions and within the countries foreign to the United States and any United States or foreign Letters Patent that may be granted therefor; and in and to said application;

Now, therefore, in consideration of the sum of One Dollar (\$1.00) paid by The University of Utah Research Foundation to the University of Utah and other good and valuable considerations, the receipt of which is hereby acknowledged, The University of Utah has sold, assigned and transferred and by these presents does hereby sell, assign and transfer unto said University of Utah

Research Foundation the entire right, title and interest in and to the said invention within the United States of America and its territorial possessions and within all countries foreign to the United States and in and to any United States or foreign Letters Patent that may be granted therefor and in and to the said application and in and to any and all divisions, reissues, continuations and extensions thereof and in and to any Letters Patent that may be granted thereon, all said rights to be held and enjoyed by The University of Utah Research Foundation for its own use and enjoyment and for the use and enjoyment of its successors and assigns to the full end of the term or terms for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by The University of Utah if this assignment, transfer and sale had not been made.

The University of Utah hereby authorizes and requests the United States Commissioner of Patents and Trademarks and all authorized officials of foreign patent offices to issue the said Letters Patent, when granted, to said University of Utah Research Foundation as the assignee of its entire right, title and interest in and to the same, for the sole use and enjoyment of said University of Utah Research Foundation, its successors and assigns.

In Testimony Whereof, The University of Utah has caused the hand of its proper representative to be subscribed hereto this 18<sup>th</sup> day of June 1999.

THE UNIVERSITY OF UTAH

By



Christina Jansen - Lloyd Sadler  
~~Director of Technology Transfer~~ Sr. Licensing Manager  
Technology Transfer

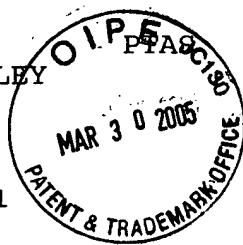
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SEPTEMBER 01, 1999

WORKMAN, NYDEGGER & SEELEY  
GREGORY M. TAYLOR  
1000 EAGLE GATE TOWER  
60 EAST SOUTH TEMPLE  
SALT LAKE CITY, UT 84111



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RECORDATION DATE: 06/18/1999

REEL/FRAME: 010063/0757  
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

HELLERMANN, WERNER

DOC DATE: 06/16/1999

ASSIGNOR:

MCCLANE, ROBERT W.

DOC DATE: 06/16/1999

ASSIGNOR:

KATZ, NIKITA E.

DOC DATE: 06/16/1999

ASSIGNOR:

BERNSTEIN, PAUL S.

DOC DATE: 06/17/1999

ASSIGNEE:

UTAH, UNIVERSITY OF, THE  
615 ARAPEEN DRIVE, SUITE 110  
SALT LAKE CITY, UTAH 84108

SERIAL NUMBER: 09335932

FILING DATE: 06/18/1999  
PATENT NUMBER:

ISSUE DATE:

KIMBERLY WHITE, EXAMINER  
ASSIGNMENT DIVISION  
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07-06-1999

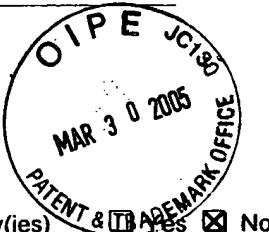


101083044

original documents or copy thereof.

## 1. Name of conveying party(ies):

Werner Gellermann  
Robert W. McClane  
Nikita B. Katz  
Paul S. Bernstein

Additional names(s) of conveying party(ies)  No

## 3. Nature of conveyance:

Assignment  Merger  
 Security Agreement  Change of Name  
 Other \_\_\_\_\_

Execution Date: 6/16/99 and 6/17/99

## 2. Name and address of receiving party(ies):

Name: The University of Utah

Internal Address: \_\_\_\_\_

Street Address: 615 Arapeen Drive, Suite 110

City: Salt Lake City State: UT ZIP: 84108

Additional name(s) & address(es) attached?  Yes  No

## 4. Application number(s) or registration numbers(s):

If this document is being filed together with a new application, the execution date of the application is: 6/16/99 and 6/17/99

## A. Patent Application No.(s)

## B. Patent No.(s)

09/335932

Additional numbers attached?  Yes  No

## 5. Name and address of party to whom correspondence concerning document should be mailed:

6. Total number of applications and patents involved:  1

Name: Gregory M. Taylor

7. Total fee (37 CFR 3.41): ..... \$ 40.00

Internal Address: WORKMAN, NYDEGGER &amp; SEELEY

 Enclosed - Any excess or insufficiency should be credited or debited to deposit account Authorized to be charged to deposit account

Street Address: 1000 Eagle Gate Tower

## 8. Deposit account number:

23-3178

60 East South Temple  
06/29/1999 JARTIS 0000008 09/335932  
04 FCG City: Salt Lake City State: UT ZIP: 84111

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## 9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Gregory M. Taylor

Name of Person Signing

Signature

3

Date

Total number of pages including cover sheet, attachments, and document: 

6/18/99

WHEN RECORDED RETURN TO:

Workman, Nydegger & Seeley  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111

PATENT APPLICATION  
Docket No: 6300.99  
Express Mail No. EL243131406US

## A S S I G N M E N T

We, Werner Gellermann, Robert W. McClane, Nikita B. Katz, and Paul S. Bernstein, of 1360 E. Kensington, Salt Lake City, UT 84105; 484 H Street, Salt Lake City, UT 84103; 732 South 400 East, #206, Salt Lake City, UT 84111; and 6633 Old Mill Circle, Salt Lake City, UT 84121, respectively, have invented a method and apparatus entitled METHOD AND APPARATUS FOR NONINVASIVE MEASUREMENT OF CAROTENOIDS AND RELATED CHEMICAL SUBSTANCES IN BIOLOGICAL TISSUE hereinafter called the "invention."

Preferred embodiments of said invention are disclosed in a United States patent application executed concurrently herewith by us and now identified as File No. 6300.99 of the law firm of Workman, Nydegger & Seeley, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, Utah 84111, and filed in the United States Patent and Trademark Office as Serial No. 09/335,932 on June 18, 1999. (We hereby authorize the attorneys of Workman, Nydegger & Seeley to insert said serial number and filing date when known.)

The Assignee, The University of Utah, an institution of higher education of the State of Utah, having a principal place of business at 615 Arapeen Drive, Suite 110, Salt Lake City, UT 84108 desires to secure the entire right, title and interest in said invention.

In consideration of One Dollar (\$1.00) and other good and valuable consideration paid to us by the Assignee, the receipt and sufficiency of which we hereby acknowledge, WE HEREBY ASSIGN TO THE ASSIGNEE:

The entire right, title and interest in said invention in the above-identified United States patent application and in all divisions, continuations and continuations-in-part of said application, or reissues or extensions of Letters Patent or Patents granted thereon, and in all corresponding applications filed in countries foreign to the United States, and in all patents issuing thereon in the United States and foreign countries.

The right to file foreign patent applications on said invention in its own name, wherever such right may be legally exercised, including the right to claim the benefits of the International Convention for such applications.

We hereby authorize and request the United States Commissioner of Patents and Trademarks, and such Patent Office officials in foreign countries as are duly authorized by their patent laws to issue patents, to issue any and all patents on said invention to the Assignee as the owner of the entire interest, for the sole use and behoof of the said Assignee, its successors, assigns and legal representatives.

We hereby agree, without further consideration and without expense to us, to sign all lawful papers and to perform all other lawful acts which the Assignee may request of us to make this Assignment fully effective, including, by way of example but not of limitation, the following:

Prompt execution of all original, divisional, substitute, reissue, and other United States and foreign patent applications on said invention, and all lawful documents requested by the Assignee to further the prosecution of any of such patent applications.

Cooperation to the best of our ability in the execution of all lawful documents, the production of evidence, nullification, reissue, extension, or infringement proceedings involving said invention.

This assignment and agreement shall be binding upon our heirs and legal representatives.

Dated this 16 day of June 1999.

Werner Gellermann

Werner Gellermann  
1360 E. Kensington  
Salt Lake City, UT 84105

Dated this 16 day of June 1999.

Robert W. McClane

Robert W. McClane  
484 H Street  
Salt Lake City, UT 84103

Dated this 16 day of June 1999.

Nikita B. Katz

Nikita B. Katz  
732 South 400 East, #206  
Salt Lake City, UT 84111

Dated this 17 day of June 1999.

Paul S. Bernstein, MD

Paul S. Bernstein  
6633 Old Mill Circle  
Salt Lake City, UT 84121



## MEMORANDUM

Date: 27 August 2003

To: Rajiv K. Kulkami, Senior Technology Licensing Manager,  
Technology Transfer Office

From: Ray Gesteland, Vice President for Research, University of Utah  
President, University of Utah Research Foundation

Subject: Delegation of Signatory Authority

This Memorandum confirms the continuing authorization, granted you since 17 September 2001, to execute and sign documents on behalf of the University of Utah and the University of Utah Research Foundation for patent documents, confidential disclosure agreements and biological and materials transfer agreements.



Raymond P. Gesteland, Ph.D.

Vice President for Research  
University of Utah

President  
University of Utah Research Foundation

University of Utah Research Foundation  
201 S PRESIDENTS CIRCLE RM 210  
SALT LAKE CITY, UTAH 84112-2311

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